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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,000	06/07/2006	Shinichi Inoue	3273-0226PUS1	9234
2292 7590 03/23/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
HEINCE, LIAM J				
ART UNIT		PAPER NUMBER		
1767				
NOTIFICATION DATE		DELIVERY MODE		
03/23/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**ADVISORY ACTION**

***Response to Amendment***

The applicant's amendment will be entered as it will simplify the issues for appeal. The remaining claim is rejected in the same manner as in the final rejection.

***Response to Arguments***

Applicant's arguments filed March 15, 2011 have been fully considered but they are not persuasive, because:

A) The applicant's argument that the instant claim does not contain product by process limitations is not persuasive. Although the claim as a whole is a method claims, the limitations with regard to the process of making the starting material is written in a product by process format. The claims do not actively require the claimed process steps in the process, but merely state that the product used can be obtained by the stated process. Absent a explicit step of preparing the polymer in the claimed method, the limitations on its production are being treated as a product by process limitation.

B) The applicant's argument that there is motivation to substitute natural rubber for the ethylene propylene rubbers of Schauder et al. is not germane. The instant claims do not require the presence of a natural rubber in the molded article. The claims require the presence of a highly hydrogenated natural rubber. As shown by Singha et al., natural rubber hydrogenated to 100% (as allowed by the claims) is in fact an ethylene propylene copolymer rather than a natural rubber (pg. 1647-48). The method of preparation recited in the claims is in fact a superior method of making the ethylene propylene used in Schauder et al. The substitution is then merely the substitution of one ethylene propylene copolymer for another made by a superior process. Thus a person having ordinary skill in the art at the time of invention would be motivated to use the polymer of Singha et al. in the article of Schauder et al.

C) The applicants argument that the optimal value of the molecular weight was not known at the time of the invention is not germane. The instant rejection does not rely upon an optimization rationale. The molecular weight limitation is taught by Schauder et al. as set forth in the rejection.

D) The applicant's argument of unexpected results is not persuasive. Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP § 716.02. The applicant has not provided an explanation of objective evidence showing that claimed invention is unexpected compared the cited references. See MPEP § 716.02(b).

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIAM J. HEINCER whose telephone number is (571)270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/

Supervisory Patent Examiner, Art Unit 1767

LJH

March 17, 2011